



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,336	08/30/1999	BRIAN J. ROBERTS	3345-2180	9002

7590 07/16/2002

KEITH R. HAUPT
WOOD, HERRON & EVANS, L.L.P.
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202-2917

EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/385,336

Applicant(s)
Roberts et al.

Examiner
Clark F. Dexter

Art Unit
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 11, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-35 and 37-48 is/are pending in the application.
- 4a) Of the above, claim(s) 3-6, 9-26, 28, 30-34, and 40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 7, 8, 35, 37-39, and 41-45 is/are allowed.
- 6) ☒ Claim(s) 27 and 29 is/are rejected.
- 7) ☒ Claim(s) 46-48 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

Art Unit: 3724

DETAILED ACTION

1. The amendment filed April 11, 2002 has been entered. It is noted that in view of the new amendment practice under 37 CFR 1.121 which became mandatory for all amendments on March 1, 2001, and due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s). It is further noted that the clean version(s) is (are) considered to be the Official version(s).

Election/Restriction

2. Newly submitted claim 40 is directed to an invention that is independent or distinct from the invention originally elected. Since applicant has received an action on the merits for the originally elected invention, claim 40 has been withdrawn from consideration as being directed to a non-elected invention.

Art Unit: 3724

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Keeny, pn 5,713,256.

Keeny discloses a module with every structural limitation of the claimed invention.

In the alternative, if it is argued that Keeny does not disclose the drive motor in the housing, the Examiner takes Official notice that providing housings to enclose an entire apparatus are old and well known in the art for various well known reasons including reducing or eliminating contamination problems in the operating portions of the apparatus and for safety reasons. Therefore, it would have been obvious to one having ordinary skill in the art to expand the housing of Keeny such that it encloses the motor for the well known benefits including those described above.

Art Unit: 3724

Allowable Subject Matter

6. Claims 2, 7, 8, 35, 37-39 and 41-45 are allowable over the prior art of record.
7. Claims 46-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed April 11, 2002 have been fully considered but they are not persuasive.

On page 7-9, applicant argues that the rejection of claims 27 and 29 over Keeny is not proper. However, the Examiner respectfully submits that applicant's position is not understood. In the first paragraph on page 8 of the amendment, applicant argues that the present invention is used with a workpiece that is significantly different than that of the prior art. Further, in the second paragraph on page 8, applicant discusses the unique problems associated with using the particular workpiece of the present invention. Applicant then argues in the paragraph in the middle of page 9 of the amendment that the specification makes clear that the inventors were concerned with the particular workpiece, and adds in the last paragraph on page 9 of the amendment that the preamble gives "meaning to the claim." However, the Examiner respectfully submits that applicant has not pointed out how the present invention is structurally different than that of the prior art to distinguish it therefrom. It is emphasized that the Examiner's position is

Art Unit: 3724

not that the prior art device is used for the same purpose as that of the present invention. Rather, the Examiner's position is that the prior art discloses and/or suggests all of the claimed structure. While it may be applicant's position that the preamble gives meaning to the claim, such meaning must be clear in the way of structural differences between the present invention and the prior art. It is respectfully submitted that applicant has not specifically pointed out structure that is claimed but not disclosed by the prior art. Further, as applicant is well aware, a functional recitation of intended use can never be relied upon to distinguish an apparatus/device over the prior art unless the functional recitation implies a structural limitation of the claimed invention. Therefore, it is respectfully submitted that the prior art rejection must be maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,


Art Unit: 3724

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
July 15, 2002